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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,758	05/26/2004	Mark Padilla	3066-03	3757
37101	7590	12/20/2005	EXAMINER	
LAW OFFICE OF MICHAEL P. EDDY 12526 HIGH BLUFF DRIVE, STE. 300 SAN DIEGO, CA 92130			CONLEY, SEAN EVERETT	
			ART UNIT	PAPER NUMBER
			1744	
DATE MAILED: 12/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/709,758	PADILLA, MARK
	<b>Examiner</b>	<b>Art Unit</b>
	Sean E. Conley	1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 November 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11/25/2005 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

## DETAILED ACTION

### ***Response to Amendment***

1. The amendment filed November 25, 2005 has been received and considered for examination. Claims 1-12 remain pending.

### ***Drawings***

2. The drawings were received on November 25, 2005. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinichi (JP 10008775 A).

Regarding claim 1, Shinichi discloses a combination candle and incense holder comprising; a vertically disposed portable base (board (1)) having an inner surface (1a) that is configured to be capable of accommodating a candle (F1) from the top portion of said base and that is configured to be capable of accommodating a receptacle (12) through an aperture (13) in said base; and a

removable receptacle (12) disposed in said aperture (13) on a wall of said base that is capable of receiving an ignitable fragrant solid (F2) or an ignitable fragrant oil (see figure; paragraphs [0001] and [0009] of the English translation).

Regarding claim 2, Shinichi discloses a receptacle (12) mounted on a top portion of the base (1) that is capable of receiving an ignitable fragrant solid (F2) or an ignitable fragrant oil (see figure 1).

Regarding claim 3, Shinichi discloses an air well (10) disposed in said base for passage and escape of air from said receptacle (12) (see figure 1).

Regarding claim 4, Shinichi discloses a receptacle (12) that is bowl shaped (see figures 1 and 2).

Regarding claim 5, Shinichi discloses a base that has a square shape (see figures).

Regarding claim 9, Shinichi discloses that the incense (F2) accommodated in said incense holder (receptacle (12)) has a stick shape (see figure 1 and 4; paragraph [0008] of the English translation).

Regarding claim 11, Shinichi discloses a receptacle that is integral to the base (see figure 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinichi as applied to claim 1 above, and further in view of Evans (U.S. Patent No. 1,665,659).

Shinichi fails to teach a receptacle comprising a handle. Evans discloses an incense burner that comprises a handle (13) attached to the incense holding receptacle (9). The handle facilitates movement of the device. This reference has been relied upon to teach that it is known to attach a handle to a receptacle holding incense. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Shinichi and incorporate a handle with receptacle (12) so that the receptacle can be easily moved or transported as taught by Evans.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinichi as applied to claim 1 above, and further in view of Radkins et al. (U.S. Patent No. 4,347,217).

Shinichi fails to teach incense that is cone-shaped. Radkins et al. discloses an incense holder that holds either an incense stick or an incense that is cone-shaped (see figures 1 and 6; col. 4, lines 4-19). This reference has been relied upon to teach that it is known to interchangeably use incense that is cone shaped or in the shape of a stick in order to dispense a fragrance.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Shinichi and replace the incense sticks with a functionally equivalent cone-shaped incense as taught by Radkins et al. in order to deodorize the surrounding air.

6. Claims 6-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinichi as applied to claim 1 above.

Shinichi fails to specifically teach the various shapes for the base and the incense as claimed by the applicant. However, it would have been an obvious matter of design choice to make the base square, cylindrical, a cone, or a star and also make the incense a stick or a cone shape since such a modification would have involved a mere change in the shape and the applicant has not provided persuasive evidence that a particular shape performs a significant advantage over other shapes. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of

ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

### ***Response to Arguments***

7. Applicant's arguments, see page 6, filed November 25, 2005, with respect to the objection of claim 1 and the rejection of claim 2 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The objection of claim 1 and the rejection of claim 2 under 35 U.S.C. 112, second paragraph have been withdrawn.
  
8. Applicant's arguments filed November 25, 2005, with respect to the rejection of claims 1-5, 9 and 11 under 35 U.S.C. 102(b) have been fully considered but they are not persuasive. The applicant argues that amended claim 1 further distinguishes the present invention of the prior art. However, claim 1 was amended to include a vertically disposed base that is *portable* and this feature is in fact taught by the invention of Shinichi (JP 10008775 A). Shinichi discloses that the votive light base (1) for graves is adjoined and installed in a grave (see paragraph [0001] of the English translation). The definition for adjoined is "to be next to" and the definition for installed is "to set in position for use" (see [www.answers.com](http://www.answers.com)). Therefore, the base (1) must be portable in order to position it or install it next a grave. Furthermore, it is not regarded as inventive to merely make an old device portable or movable without

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producing any new and unexpected result (see Ranco, Inc. v. Gwynn et al., 128 F.2d 437 [54 USPQ 3]).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Conley whose telephone number is 571-272-8414. The examiner can normally be reached on M-F 8:30-5:00.

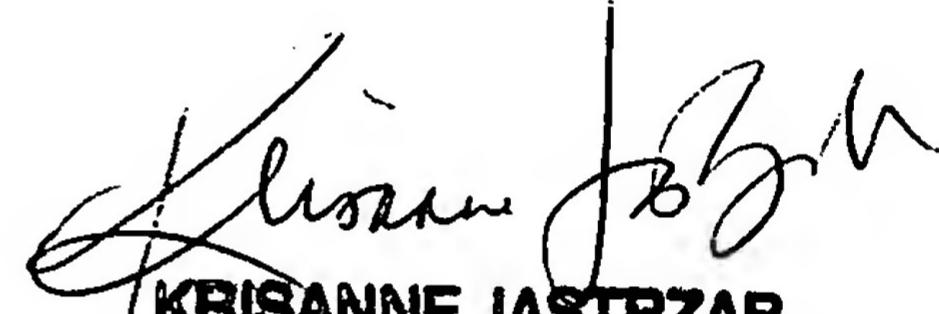
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 571-272-1226. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEC  
December 13, 2005



KRISANNE JASTRZAB  
PRIMARY EXAMINER